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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/725,249

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BAKER BOTTS L.L.P.

PATENT DEPARTMENT

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AUSTIN, TX 78701-4039

EXAMINER

PYO, MONICA M

ART UNIT

PAPER NUMBER

2161

MAIL DATE

DELIVERY MODE

03/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/725,249

Applicant(s)

NECSOU ET AL.

Examiner

MONICA M. PYO

Art Unit

2161

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This communication is responsive to Amendment filed 3/6/2007.
2. Claims 1-9 and 11-15 are currently pending in this application. Claims 1 and 15 are independent claims. In the Amendment filed 3/6/2007, claims 1-2, 11 and 13 are amended, claim 10 is canceled and claim 15 is newly added. This action is made *Final*.

Declaration under Rule 37 CFR, § 1.31 Affidavits

3. The affidavit filed on 10/5/2006 under 37 CFR § 1.131 has been considered but is ineffective to overcome the Publication "Metadata and GIS; An ESRI White Paper", published on October 2002 ERIS (hereinafter ERIS) reference.

4. From MPEP § 715.04[R-5]:

The following parties may make an affidavit or declaration under 37 CFR 1.131:

(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

(C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate. .

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. Ex parte Foster, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims.

5. In the interest of compact prosecution, the Examiner has considered the content of the declarations below:

*"In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, 'there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice.' In re Asahi/America Inc., **>68 F.3d 442, 37 USPQ2d 1204, 1206< (Fed. Cir. 1995) (Citing Newkirk v. *>Lulejian<, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and Sachs v. Wadsworth, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.)" (MPEP 715.07 III)*

"For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. King Instrument Corp. v. Otari Corp., 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985). For additional cases pertaining to the requirements necessary to establish actual reduction to practice see DSL

Dynamic Sciences, Ltd. v. Union Switch & Signal, Inc., 928 F.2d 1122, 1126, 18 USPQ2d 1152, 1155 (Fed. Cir. 1991) ("events occurring after an alleged actual reduction to practice can call into question whether reduction to practice has in fact occurred"); *Corona v. Dovan*, 273 U.S. 692, 1928 C.D. 252 (1928) ("A process is reduced to practice when it is successfully performed. A machine is reduced to practice when it is assembled, adjusted and used. A manufacture [i.e., article of manufacture] is reduced to practice when it is completely manufactured. A composition of matter is reduced to practice when it is completely composed." 1928 C.D. at 262-263 (emphasis added).); *Fitzgerald v. Arbib*, 268 F.2d 763, 765-66, 122 USPQ 530, 531-32 (CCPA 1959) ("the reduction to practice of a three-dimensional design invention requires the production of an article embodying that design" in "other than a mere drawing")" (MPEP 2138.05).

6. Exhibit A, submitted as a written and figure descriptions, do not constitute an actual reduction to practice and fail to establish that they reduced to practice working model. A written description, no matter how complete, which has not been made the subject of a US patent application, does not qualify as reduction to practice. Accordingly, Applicants have not established prior invention. The rejection is maintained.

Requirements under Rule 37 CFR. § 1.105

7. Applicant and the assignee of this application are required under **37 CFR 1.105** to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

8 In response to this requirement, please provide copies of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of:

A). A copy of slides/documents used for the U.S. Nuclear Regulatory Commission, Internal Meeting, Rockville, Maryland, dated August 2001.

B). A copy of slides/documents used for EOS (at 2002 Annual Fall Meeting) dated December 2002.

9. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

Claim Objections

10. Claim amendment received on 10/5/2006. The changes are acknowledged and accepted. Therefore, the claim objections made in a prior Office Action are withdrawn.

11. Claim 13 is objected because of the following informalities:

Regarding claim 13, the claim limitation of "an XML file", in lines 3 was absent from the amended claim. Applicant should amend claim in accordance with CFR 1.121(c)(2) (i.e., The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived).

Appropriate correction is required.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-9, 11-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Publication “Metadata and GIS; An ESRI White Paper”, written by ESRI, published on October 2002 (hereinafter ESRI), in view of U.S. Patent No. 6,879,988 issued to Basin et al. (hereinafter Basin), and further in view of U.S. Patent Publication No. 2003/00590919 by Brown et al. (hereinafter Brown).

Regarding Claims 1 and 15, ESRI disclose a method of providing access to geodata, the geodata having been acquired by an enterprise having an in-house data communications network, comprising the steps of:

A). using a metadata builder to access geodata input files and to generate metadata files associated with the geodata files (ESRI: pg. 1, [GIS Data Sharing on the Internet Is a Reality]; pg. 1, [ESRI Supports Metadata]);

B). the geodata input files (ESRI: pg. 1, [GIS Data Sharing on the Internet Is a Reality])

C). storing metadata files in a repository serviced by the in-house data communications network (ESRI: pg. 3, [How Does ESRI Support Metadata?]; pg. 6, [ArcSDE]);

D). using a metadata harvester to retrieve the metadata files from the repository and to build a metadata database (ESRI: pg. 7, lns. 1-4; pg. 7, [Discovering Metadata With ArcCatalog]);

E). wherein the metadata harvester retrieves the metadata files as XML (eXtensible Markup Language) and (ESRI: pg. 7, lns. 1-4);

F). wherein the metadata harvester comprises a file locator for retrieving XML files, a metadata compiler for compiling retrieved XML files, a converter for retrieving files and converting them to ANSI format, and a database builder for formatting the compiled and converted metadata files to relational database format (ESRI: pg. 3, [Digital Communication Standards]; pg. 7, [Discovering Metadata]; pg. 8, [With Clearinghouse (Z39.50) Clients]);

G). storing the metadata files in relational database format in a metadata database (ESRI: pg. 3, [How Does ESRI Support Metadata?]);

H). wherein the metadata database is accessible by an internet server, (ESRI: pg. 5, [Publishing Metadata]); and

I). using the internet server to: communicate via the Internet with a user's web browser; to receive query data from the web browser; to respond to the queries by accessing the metadata database; a results page containing a list of records (ESRI: pg. 7, [With ArcCatalog]), each record having a metadata link to metadata associated with the record (ESRI: pg. 7, [With Metadata Explorer]); a metadata page in response to activation of the metadata link, the metadata page containing metadata and at least one link; to retrieve file from the repository in response to activation of the link; and to download locally the file via a web browser (ESRI: pg. 6, [ArcSDE]; pg. 6, [Clearinghouse Support]).

ESRI does not explicitly disclose:

B). using a file converter to convert to downloadable archive files;

I). to download a page; to retrieve the archive files and

However, Basin discloses:

B). using a file converter to convert to downloadable archive files, the compression/extraction component's functionality (Basin; col. 2, lns. 50-54; col. 4, lns. 48-52);

I). To download a page, as the handling of downloaded zip files (Basin: col. 2, lns. 50-54); **to retrieve the archive files,** as the handling of archive files (Basin: col. 4, lns. 48-52).

It would have been obvious to person with ordinary skill in the art at the time of invention to modify the teachings of ESRI with the teachings of Basin to utilize the compression/extraction component to utilize archiving files with the motivation to enhance a quick and easy management and manipulation of complex zip archive files (Basin: col. 2, lns. 40-48).

ESRI and Basin do not explicitly disclose:

E)/F). HTML (HyperText Markup Language) metadata files.

However, Brown discloses:

E)/F). HTML (HyperText Markup Language) metadata files, (Brown: [0130], lns. 7-10).

It would have been obvious to person with ordinary skill in the art at the time of invention to modify the teachings of ESRI and Basin with the teachings of Brown to utilize the storing method of HTML metadata file with the motivation to enhance the method of identifying the accessed content is obtained, monitored or kept in a record (Brown: [0010], lns. 1-4).

Regarding Claim 2, ESRI and Basin and Brown disclose the method wherein the retrieving step is performed by retrieving an eXtensible Markup Language (XML) metadata file

and an HyperText Markup Language (HTML) metadata file for each archive file (ESRI: pg. 2, [What Is Metadata?]) and (Basin: col. 4, lns. 48-54) and (Brown: [0130], lns. 7-10).

Regarding Claim 3, ESRI and Basin and Brown disclose the method wherein one or more file formats and archive files are derived from a number of geodata input files (ESRI: pg. 1, [GIS Data Sharing on the Internet Is a Reality]) and (Basin: col. 4, lns. 48-54).

Regarding Claim 4, ESRI and Basin and Brown disclose the method wherein the archive files are lossless compressed data files (Basin: col. 4, lns. 48-54; col. 7, lns. 35-38).

Regarding Claim 5, ESRI and Basin and Brown disclose the method wherein the geodata input files may be any of the following formats: vector, raster, or tabular (ESRI: pg. 1, [GIS Data Sharing on the Internet Is a Reality]; pg. 7, [Discovering Metadata With ArcCatalog]).

Regarding Claim 6, ESRI and Basin and Brown disclose the method wherein the metadata database is a relational database (ESRI: pg. 6, [ArcSDE]).

Regarding Claim 7, ESRI and Basin and Brown disclose the method wherein the database access is via a Z39.50 server (ESRI: pg. 3, [Digital Communication Standards]).

Regarding Claim 8, ESRI and Basin and Brown disclose the method wherein the metadata harvester retrieves metadata on a periodic basis (ESRI: pg. 7, [Discovering Metadata

With ArcCatalog]).

Regarding Claim 9, ESRI and Basin and Brown disclose the method wherein the metadata harvester retrieves only metadata files which are new since a prior harvest (ESRI: pg. 7, [Discovering Metadata With ArcCatalog]).

Regarding Claim 11, ESRI and Basin and Brown disclose the method wherein the metadata complies with the Federal Geographic Data Committee (FDGC) standard or other metadata standards (ESRI: pg. 1, [ESRI Supports Metadata]; pg. 5, [Standards-Based Metadata Tools]).

Regarding Claim 12, ESRI and Basin Brown disclose the method wherein the internet server may receive query data in any one of the following formats: spatial, keyword, or temporal (ESRI: pg. 3, [Digital Communication Standards]; pg. 6, [Clearinghouse Support]).

Regarding Claim 13, ESRI, Basin, and Brown disclose the method wherein each record has a first metadata link to an HyperText Markup Language (HTML) metadata file and a second metadata link to an ASCII metadata file (ESRI: pg. 3, [Digital Communication Standards]; pg. 8, [With Clearinghouse (Z39.50) Clients]; pg. 9, lns. 1-4) and (Brown: [0130], lns. 7-10).

14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over ESRI in view of Basin, further in view of Brown, as applied to claims 1-9, 11-13 and 15 above, and further in

view of published website of “Geography Network”, published on 8/1/2001 at <http://web.archive.org/web/20010801165214/www.geographynetwork.com/data/index.html>) (hereinafter Geography).

Regarding Claim 14, ESRI and Basin and Brown disclose the method wherein the metadata page further contains associated with the metadata (ESRI: pg. 5, [Supported Data Types]).

ESRI and Basin and Brown do not explicitly disclose: a thumbnail image of a map.

However, Geography discloses: a thumbnail image of a map (Geography: geography network, pg. 1).

It would have been obvious to person with ordinary skill in the art at the time of invention to modify the teachings of ESRI and Basin and Brown with the teachings of Geographic to utilize the geographic data for mapping system to enhance accessing a collection of geographic data (Geography: Ins. 1-10).

Response to Arguments

15. Applicant's arguments filed 3/6/2007 have been fully considered but they are not persuasive. Applicants submitted the declarations under 37 CFR 1.131 to swear behind the ESRI reference. However, the declarations are not sufficient to overcome the ESRI reference for the reasons above in the ***Declaration under Rule 37 CFR. § 1.31 Affidavits.***

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MONICA M. PYO whose telephone number is (571)272-8192. The examiner can normally be reached on Mon & Thur 7:00 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Monica M Pyo
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2/27/2008

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